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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LE, DAVID Q

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/662,958

Applicant(s)

MANI, GANESH

Examiner

David Q Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-89 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-89 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Per the Amendment filed on January 9th, 2004:

Claims 1 and 52 were amended.

Claims 1-89 remain pending.

Drawings

2. An amended drawing was received on January 9th 2004. This drawing has been forwarded to Draftsperson for review.

Response to Arguments

3. Applicant's remarks and arguments presented in the Amendment filed on January 9th 2004 have been fully considered.

The arguments with respect to the rejections of claims 1-32 and 52-89 under 35 U.S.C. § 101 are persuasive; the rejection of these claims is withdrawn.

The rejection of claim 52 under 35 U.S.C. § 112 has been resolved by the claim being amended to recite that the instructions are stored on a computer-readable medium.

The argument with respect to the rejection of claim 71 under 35 U.S.C. § 112 is not persuasive. The document cited by Applicant (<http://www.uspto.gov/web/offices/pac/dapp/pdf/compenex.pdf>) is an old training document, no longer applicable to current examination guidelines regarding computer-related inventions, especially as these are directed to signal carrying media.

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Rather, the current official guideline states that a signal per se is not the type of subject matter that is considered statutory. If the signal claim is interpreted as an abstract arrangement "to be transmitted", or as a transmission in transit, rather than a physical signal statically embedded in a physical computer readable medium, the signal claim is considered non-statutory.

Rationale: There is no case history standing for the proposition that a signal in transit, no matter how useful the contents, is statutory subject matter. A signal is insubstantial and therefore neither concrete nor tangible. It is a pattern that is evident over a period of time by measuring the changes in level of some attribute, such as voltage or current, at a given point. A signal in transmission is none of a process, machine, manufacture, or composition of matter, or any new and useful improvement thereof. It is information transmitted as energy, encoded to endow it with intelligible patterns for subsequent interpretation. Again, neither tangible nor concrete.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 71-89** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter:

Claim 71 seems is directed to a transmission medium or a signal, a non-statutory subject matter.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly

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claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 33, 52 and 71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 1, 33, 53, and 71.

Steps (e) and (f) of the claimed method do not seem to require the use of a computer, nor is it clear that they are computer-implemented steps. Step (e), the act of an agent performing a requested service, may or may not be computer-implemented. Step (f), the act of the principal paying said agent, again, may or may not be electronically performed. As a consequence, the claims are indefinite and do not distinctly claim the subject matter which applicant regards as the invention.

As per claim 71.

It is not clear how a data transmission medium may "contain" instructions. The claim's language is indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. See response to arguments above.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. **Claims 1, 33, 52 and 71** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Walker et al**, US Patent No. 5,862,223 in view of **Lloyd**, US Patent No. 4,876,648.

Walker discloses

A computer [*implemented method / readable medium / system having a computer readable medium / data transmission medium containing instructions*] for a principal to electronically establish and use an agent (Walker's "expert"; Abstract; Summary of the Invention), said method comprising the steps of

- (a) said principal identifying a service requirement (Fig 1, 6; associated text);
- (b) said principal submitting an electronic request for service (Fig 6; associated text);
- (c) negotiating terms by principal and agent (Fig 7, 8, 16, 30-33; associated text);
- (d) establishing an electronic power of attorney;
- (e) said agent performing said requested service (all above citations); and
- (f) said principal paying said agent (Fig 9-14; 18; associated text).

Walker does not mention using an electronic power of attorney between principal and agent.

However, Lloyd describes a computerized mortgage system where electronic power of attorneys are used between principal and various financial agents (Abstract; Summary of the Invention; Col 7, L64 – Col 8, L6; Col 8, L16-28).

It would have been obvious to one ordinarily skilled in the art at the time the invention was made to have included a power of attorney capability as taught by Lloyd in a system patterned after Walker's, for the purpose of allowing experts or agents hired by principals to act on their behalf and render the services requested by those principals. Such capability would make the system more versatile and therefore more attractive to both potential principals and agents alike.

As per **claims 2, 34, 53, 72**.

Walker further discloses

- (a) identifying the service requested (Fig 6, associated text);
- (b) providing a database having information relating to available agents (Fig 2, associated text);

and

(c) connecting an agent able to perform said requested service with said principal (Fig 1, 3, 15-18; associated text).

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As per **claims 3, 35, 54, 73.**

Walker further discloses (see all above citations)

(a) said principal identifying terms and conditions relating to the performance of said requested service; and

(b) transmitting said terms and conditions to available agents.

As per **claims 4, 36, 55, 74.**

(a) establishing constraints on the performance of said agent (see all above citations).

As per **claims 5, 37, 56, 75.**

Walker further discloses

said constraint is a soft constraint (see all above citations).

As per **claims 6, 38, 57, 76.**

Walker further discloses

said constraint is a hard constraint (see all above citations).

As per **claims 7, 20, 39, 58, 77.**

Walker does not disclose

...said step of establishing an electronic power of attorney includes the steps of.

(a) generating a power of attorney document; and

(b) electronically signing said power of attorney document.

However Walker does disclose using cryptographic methods for signing and authenticating transmission from and to principals and agents alike, to preserve security (Fig 16, 25-28; associated text). Also, Lloyd teaches the use of electronic power of attorneys in his system (see Lloyd citations as per claims 1, 33, 52 and 71 above). It would have been obvious to one ordinarily skilled in the art at the time the invention was made to have included the claimed features in a system matching principals and agents, so that fraud and security problems would not arise within the system's electronic transmissions.

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As per claims 8, 21, 40, 59, 78.

Walker does not disclose

...step of establishing an electronic power of attorney further includes the steps of

(a) electronically verifying said electronic signature; and

(b) providing an electronic key that allows said agent to access selected information about said principal electronically.

However Walker does disclose that experts/agents will have access granted to them to principals' private data as needed in the performance of their duties (Fig 23, associated text).

Combined with the Lloyd teachings as analyzed for the above set of claims, this would have made it obvious to one ordinarily skilled in the art at the time the invention was made that the claimed limitations would have been included in the system, so that hired agents may have the information they need to adequately perform the duties they were hired for, while preserving the security of the principals' private information at the same time.

As per claims 9, 22, 41, 60, 79.

Walker further discloses

electronic verification is performed by an asymmetric cryptosystem (Fig 16, 26-27; associated text).

As per claims 10, 23, 42, 61, 80.

Walker further discloses

electronic verification is performed by a biometric method (Col 10, line 27-29).

As per claims 11, 24, 43, 62, 81.

Walker further discloses

said selected information about said principal is stored in an information database and said step of agent performing said requested service includes the steps of

(a) said agent accessing said principal information database (see all above citations); and

(c) said agent reporting completion of said requested service to said principal (see all above citations).

Walker does not disclose

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(b) said agent interacting with third parties to perform said requested service

However Lloyd teaches that third parties may be involved in the performance of services of an agent on behalf of a principal (Summary of the Invention; also see all above Lloyd citations). Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have included these claimed features in the system so that hired agents may use third parties in the performance of their duties, without needing to have the third parties contact the principals themselves, thus saving time and streamlining the whole process.

As per claims 12, 25, 44, 63, 82.

Walker does not disclose

said third parties can electronically verify the status of said agent.

However Lloyd does disclose that many third parties will be involved in the performance of specific services on behalf of a principal (Fig 2a-b; associated text). It would have been inherent in Lloyd's system that those third parties would need to be aware of or have access to the status of each of the participants in any transaction they become parties to, in order to establish the mutual trust necessary for such transactions. It would have been obvious to one ordinarily skilled in the art at the time the invention was made that this feature would be included in Walker's system as well, in order for third parties to trust the agent they will work with on behalf of the principals the agents represent. Absent such status verification, no trusted cooperation between agents and third parties would ensue.

As per claims 13, 26, 45, 64, 83.

Walker does not disclose

(a) said agent updating said information database with a status report; and

(b) said principal accessing said information database.

However, Lloyd does disclose that reports will be generated at every step of a service being rendered on behalf of a principal (Fig 4a-b; associated text). It would have been obvious to one ordinarily skilled in the art at the time the invention was made to include this feature, so that principals may follow the progress of a hired agent, thus making the system more attractive to them.

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As per claims 14, 27, 46, 65, 84.

Walker does not disclose

- (a) said agent generating a status report; and
- (b) said agent delivering said report to said principal.

However, Lloyd does disclose these limitations (see above citations). It would have been obvious to one ordinarily skilled in the art at the time the invention was made to include this feature, so that principals may follow the progress of a hired agent, thus making the system more attractive to them.

As per claims 15, 28, 47, 66, 85.

Neither reference discloses

- (a) said principal terminating said power of attorney.

However Lloyd describes the power of attorneys used in his system as "temporary" (see previous Lloyd citations). Therefore it means that these documents would be terminated, either when the have served their purpose, after a certain period of time, or in the case of non-performance from the party to whom the power of attorney was granted. It would have been obvious to one ordinarily skilled in the art at the time the invention was made that this feature would be inherent in the system, so that power of attorneys may be revoked; such feature is a failsafe mechanism protecting principals in case anything goes wrong with a contract they entered into for service with agents, and would make prospective principals more comfortable with using the service.

As per claims 16, 29, 48, 67, 86.

Neither references discloses

- (a) terminating said power of attorney upon said agent violating said terms and conditions or said constraints.

However Lloyd describes the power of attorneys used in his system as "temporary". Therefore it means that these documents would be terminated, either when the have served their purpose, after a certain period of time, or in the case of non-performance from the party to whom the power of attorney was granted. It would have been obvious to one ordinarily skilled in the art at the time the invention was made that this feature would be inherent in the system, so that power of attorneys may be revoked; such feature is a failsafe mechanism protecting principals in case there is non-performance with a contract they entered into for service with agents, and would make prospective principals more comfortable with using

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the service.

As per claims 17-19, 30-32, 49-51, 68-70, 87-89.

Walker further discloses all the various payment methods recited in these claims (see all above citations):

principal paying said agent includes the steps of

(a) said principal paying a web site provider for an allotment of agent time;

(a) paying said agent a fixed fee;

(a) paying said agent an hourly basis;

(b) deducting the time said agent spent on said step of said agent performing said requested service from said time bank; and

(c) said web site provider paying said agent for said requested service.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q Le whose telephone number is 703-305-4567. The examiner can normally be reached on 8:30am-5:30pm Mo-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DQL



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